



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S) : Chu, et al.
SERIAL NO. : 09/849,870
FILED : May 4, 2001
FOR : THERAPEUTIC AZIDE COMPOUNDS

GROUP ART UNIT : 1623
Examiner : Patrick T. Lewis

Commissioner for Patents
Washington, D.C. 20231

#9
3-22-03
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**Election of Invention in Response
to Restriction Requirement**

In response to the Examiner's correspondence dated January 23, 2003, pursuant to the Examiner's restriction requirement in the above-referenced patent application, Applicants provisionally elect with traverse to prosecute the invention of group I, namely claims 1 and 7-13, which are drawn to a pharmaceutical composition comprising an azide derivative of a drug and a suitable pharmaceutical carrier, classified in class 514, subclass 42 and further elect with traverse a species wherein the azide group occurs in place of A) an amino moiety (species 1) and wherein the azide derivative is a purine (species 2). Notwithstanding the election of species as set forth above, Applicants respectfully request that the Examiner give serious consideration to examining a species wherein the azide group occurs in place of A) an amino moiety and C) a hydroxyl moiety (species 1) and wherein the azide derivative is a purine or a nucleoside analog (species 2). The requested groups are somewhat broader than the species the Examiner requests Applicants to elect, but Applicants feel that examining two species which are related would materially advance the prosecution of this application and provide administrative efficiency.

Claims 1, 7 and 13 are readable on the elected species, whether that species is the narrower species or the more broad suggested species Applicants wish to have the Examiner consider.

Restriction Requirement
S.N. 09/849,870

Applicants respectfully traverse the Examiner's requirement for restriction. Applicants respectfully request the Examiner reconsider his restriction requirement. Applicant respectfully submits that prosecution of all of previously elected claims 1 and 7-13 without regard to the imposed species limitation is a sufficient restriction for the Examiner to examine all claims without being subjected to an undue burden as discussed hereinbelow.

According to M.P.E.P. §803, restriction by the Examiner of patentably distinct inventions is proper if the claimed inventions are independent and a *serious burden* would be placed on the Examiner if restriction was not required. Applicant respectfully submits that the presentation of the originally filed claims would not place such a serious burden on the Examiner as to require restriction. All of the originally restricted claims are directed to related, though patentably distinct chemical compositions.

Thus, it is Applicants strongly held view that any search the Examiner would need to conduct in examining the instant application of all of claims 1 and 7-13 would not be unduly burdensome. This is clearly evidenced by the Examiner indicating that the searches for the examination of all the claims of the instant application *fall within the identical class (514) and subclass (42)*. Moreover, the examination of all of the originally filed claims in the instant application would not place such a serious burden on the Examiner as to require restriction. This is particularly true given the fact that the present application is a divisional application, the Patent Office has already had the opportunity of examining the claims in the parent application and all of the claims are directed to inventions which are classified in the identical class and subclass.

Applicants understand the general policy considerations for the Patent Office's requirement for restriction in certain instances. In this instance, however, those considerations do not weigh in favor of restricting the inventions here. In determining the appropriateness of restriction, one must also consider the countervailing consideration that, in each instance,

Applicants wish the Patent Office examine their patent application with a certain degree of "administrative efficiency" and wish to have patent claims issue which reflect the breadth of their invention.

Applicants respectfully submit that claims 1 and 7-13 are sufficiently narrow to allow the Examiner to determine patentability without being subjected to the serious burden referred to in M.P.E.P. §803. Consequently, Applicant respectfully requests that the Examiner withdraw the restriction requirement. Alternatively, in the interest of administrative efficiency, Applicants respectfully request that the Examiner extend consideration to examining the claims which are directed to the two species which are presented above, in particular, species which are azide derivatives wherein the azide group occurs in place of both an amino moiety and a hydroxyl moiety and wherein the azide derivative is a purine or a nucleoside. Claims 1, 7 and 13 are presently readable thereon. It is respectfully submitted that these combined species are sufficiently narrow to allow an efficient examination of the pending application. Indeed, the same claims would be examined regardless of whether the narrower or broader species were examined.

Separately, the Examiner has indicated that the previously submitted information disclosure statement does not contain references listed on a proper information disclosure statement. Applicants had previously submitted an information disclosure statement dated December 27, 2001, which listed all previously considered references from the parent application serial number 09/033,996 (based upon PCT/US96/14494) on a PTO-1449 form. Applicants are confused about the Examiner's comments regarding the filing of the previously submitted information disclosure statement, which Applicants believed properly listed all references previously considered by the Examiner in the parent application. Clarification of the Examiner's statements is respectfully requested.

A supplemental information disclosure statement is enclosed as is a petition for an

extension of time of one month and a check in the amount of \$55.00.

The Examiner is cordially requested to call the undersigned attorney if the Examiner believes that a telephonic discussion may materially advance the prosecution of the instant application in any way.

Respectfully submitted,

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By: 

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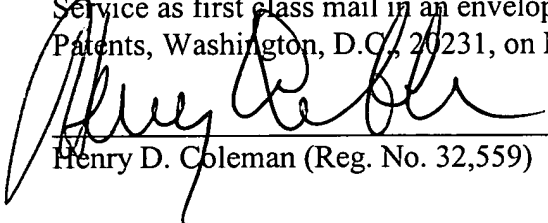
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Dated: March 3, 2003

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, Washington, D.C., 20231, on March 3, 2003.


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